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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,083	06/25/2003	James Panks	71476-0003	1082
20915	7590	03/10/2005	EXAMINER	
MCGARRY BAIR PC 171 MONROE AVENUE, N.W. SUITE 600 GRAND RAPIDS, MI 49503			HONG, JOHN C	
			ART UNIT	PAPER NUMBER
			3726	

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/604,083	<b>Applicant(s)</b> PANKS, JAMES	
	<b>Examiner</b> John C. Hong	<b>Art Unit</b> 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2004.  
2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.  
4a) Of the above claim(s) 19-22 is/are withdrawn from consideration.  
5) ☒ Claim(s) 32-36 is/are allowed.  
6) ☒ Claim(s) 1-9 and 12-18,23-29 is/are rejected.  
7) ☒ Claim(s) 10,11,30,31 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of claims 1-18 and 23-26 in the reply filed on 11/29/04 is acknowledged. The traversal is on the ground(s) that : (1) the claims 19-22 can be practiced by another materially different apparatus or by hand. Indeed it is obvious that because a percussive tool must be used to remove the component from its seat in claims 19-22, the component must be sufficiently tightly seated that it cannot be removed by hand;(2) Invention I as classified in class 83, and invention 11 as classified in class 29, subclass 426.1. Class 83 relates to method and machines for cutting or penetrating material, the burden on the Examiner will not be increased by having to conduct a search to both alleged inventions.

This is not found persuasive because (1) On the office action dated 10/28/04, it was mentioned ; In this case the process as claimed can be practiced by another materially different apparatus or by hand such as the process does not require a coupling comprises a tool holder, a coupling adapter and a rod puller. It was not mentioned that the claims 19-22 can be practiced by another materially different apparatus or by hand; (2) the burden on the Examiner will be increased by having to conduct a search to both alleged inventions.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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3. Claims 3,5,6,13,15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(1) Claim 3, line 1, "the tool body" lacks antecedent basis.

(2) Claim 5, lines 2 and 4 ; and Claim 6, line 2, "rod puller" should be -- puller rod--. It gives an impression that this part is for pulling a rod.

(3) Claim 13, line 1, "the coupling" lacks antecedent basis.

(4) Claim 15, line 1, "the coupling" lacks antecedent basis.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1,3,5-9,12,13,15-18 and 23-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Henderson (U.S. Patent 5,638,909).

Henderson discloses :Regarding Claims 1,3,5-9, a tool for removing a component from a seat, comprising. a hand-held, pneumatically-driven hammer (110) for applying a repeating percussive force; and a coupling (10) for interconnecting the hammer and the component (102), wherein the repeating percussive force is applied to the component thereby urging the component from the seat (Figs 3 and 4; col. 4, line 24- col. 5, line 62), wherein the coupling (10) interconnects a tool body; wherein the coupling comprises a tool holder (40), a coupling adapter (20), and a rod puller (60), and the coupling adapter is adapted to transfer the percussive force

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from the tool holder to the rod puller; the coupling comprises a sleeve (20) adapted to slidably communicate with an exterior surface of the hammer and fixedly retain the hammer therein; and further comprising a pulling bit (112) attached to the hammer and adapted to apply the percussive force to the component; the coupling is attaches forward end of the hammer;

Regarding Claims 12,13,15-18, an adapter (10)for converting an air hammer (110) with a reciprocating member into a tool for removing a component (102) from a seat, comprising: a pull rod adapted to be attached to the component, and a hammer piece (112) attached to the reciprocating member and adapted to percussively communicate with the pull rod (60); wherein the reciprocating member imparts a reciprocating motion to the hammer piece so that a repeating percussive force is applied to the pull rod by the hammer piece thereby urging the component (102) from the seat (Figs 3 and 4; col. 4, line 24- col. 5, line 62); wherein the coupling interconnects the tool body and the component; wherein the coupling comprises a tool holder (40), a coupling adapter (20), and a rod puller (60), and the coupling adapter is adapted to transfer the percussive force from the tool holder to the rod puller, wherein the coupling adapter is adapted to enable the rod puller to translate relative to the tool holder, wherein the coupling comprises a sleeve (20) adapted to slidably communicate with an exterior surface of the hammer and fixedly retain the hammer therein, and further comprising a pulling bit (112) attached to the hammer and adapted to apply the percussive force to the component (102); and

Regarding Claims 23-29, a kit (10) for converting an air hammer into a tool for removing a component (102) from a seat, the air hammer comprising a body and a reciprocating member, the kit comprising: a pull rod (60) attached to the component, and a pulling member (112) attached to the air hammer and adapted to percussively communicate with the pull rod (60) (Figs

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3 and 4; col. 4, line 24- col. 5, line 62); wherein the reciprocating member is operably interconnected with the component (102), wherein the air hammer body is operably interconnected with the component, and further comprising a coupling (20) comprising a tool holder (40), and a coupling adapter (20), and the coupling adapter is adapted to transfer the percussive force from the tool holder to the pull rod (60), wherein the coupling adapter is adapted to enable the pull rod to translate relative to the tool holder, wherein the coupling comprises a sleeve (20) adapted to slidably communicate with the body of the hammer and fixedly retain the hammer therein wherein the coupling is attached to a forward end of the hammer.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647 (1987).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2,4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henderson (U.S. Patent 5,638,909) in view of Deike (U.S. Patent 4,168,751).

Regarding Claims 2 and 4, Henderson teach the limitations except the hammer comprises a tool body comprising an anvil and enclosing a piston, and the piston strikes the anvil to apply

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the percussive force to the tool body, and further comprising a spring adapted to urge the piston away from the anvil after the application of the percussive force.

Deike teaches a hammer comprises a tool body (11) comprising an anvil (24a) and enclosing a piston (22), and the piston strikes the anvil to apply the percussive force to the tool body, and further comprising a spring (34) adapted to urge the piston away from the anvil after the application of the percussive force (Fig. 2; col.5, line 31- col.6, line 60).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize the tool body and the spring as taught by Deike on the tool of Henderson so as to prevent peoning or damaging the component.

Regarding Claim 14, Henderson teaches the limitation except a spring adapted to urge the piston away from the anvil after the application of the percussive force.

Deike teaches a spring (34) adapted to urge the piston away from the anvil after the application of the percussive force (Fig. 2; col.5, line 31- col.6, line 60).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize the spring of Deike on the adapter of Henderson so as to prevent peoning or damaging the component.

***Allowable Subject Matter***

8. Claims 32-36 are allowed.

9. Claims 10,11,30 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John C. Hong whose telephone number is 571-272-4529. The examiner can normally be reached on M-F(07:00-16:30)First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John C. Hong  
Primary Examiner  
Art Unit 3726

jh  
06 March, 2005